

REMARKS/ARGUMENTS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which Applicants regard as the invention.

Claim 1 has been amended to better describe certain aspects of the invention. Since the main elements added to claim 1 exist in claim 2 and the element deleted from claim 1 did not exist in the original claim 1 and added in the previous amendment, the Examiner must have studied all the elements exist in currently amended claim 1. The term "first" has been added merely to avoid a confusion between the first information recording medium and the second information recording medium. Therefore the amendment places the application in condition for allowance, does not require further searching, and/or places the claims in a better position for appeal, entry is respectfully requested. Favorable reconsideration in light of the amendment and the remarks which follow is respectfully requested.

Claims 1 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over NUOVO et al. (US patent publication 2004/0077391 A1, hereinafter "NUOVO") in view of KATO (US patent publication 2003/0013418 A1). For at least the following reasons, the rejection is respectfully traversed. The asserted combination of NUOVO and KATO does not teach or suggest all features of the claimed invention.

Claim 1 has been amended to recite a second information recording medium storage portion, for detachably storing a second information recording medium in which information is recorded, is disposed adjacent to the battery housing portion and wherein the second information recording medium storage portion and the battery housing portion are substantially provided in one plane. The amendment is supported by the original specification, for example, Fig. 7 of the application. Neither NUOVO nor KATO discloses a

first information recording medium storage for storing a first information recording medium in which the first information recording medium storage portion being disposed in adjacent to the battery attachment portion and a second information recording medium storage for storing a second information recording medium in wherein the second information storage portion and the battery housing portion are substantially provided in one plane, as recited in amended claim 1. Thus, the asserted combination of NUOVO and KATO does not render the subject invention obvious because the combination fails to disclose, suggest, or teach every feature of the claimed invention.

Claims 2-5 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over NUOVO in view of KATO and further in view of KIM (US patent 6,681,120 B1). For at least the following reasons, the Examiner's rejection is respectfully traversed. The asserted combination of NUOVO, KATO and KIM does not teach or suggest all features of the claimed invention.

In the Office action, the Examiner concedes that the combination of NUOVO, KATO and KIM does not disclose that the second information recording medium storage portion is disposed adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing. The Examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to design a portable device to include a second information recording medium storage portion disposed adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing, since it has been held that rearranging parts of an invention involves only routine skill in the art. In the claimed invention, since a first information recording medium storage portion detachably stores a first information recording medium toward a battery attachment portion side and adjacent to the battery attachment portion, a battery housing portion is constituted by the battery attachment portion and the first information recording medium storage portion the

battery housing portion is covered by a cover member, and a second information recording medium storage portion is disposed adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing. With all these features it is possible to house two kinds of the information recording mediums within a limited space (housing) (see page 4, line 17-page 5, line 20 of the application). The grounds for the rejection fail to offer any explanation as to why one of ordinary skill in the art would have considered the proposed modification obvious. Therefore, the grounds of the rejection fails to contain the elements necessary to establish a prima facie case of obviousness for claims 2-5 (See, e.g., MPEP § 706.02(j)).

Furthermore, the Examiner has not provided the proper motivation for modifying the reference. The burden is on the Examiner to make a prima facie case of obviousness (MPEP § 2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP § 2143.01).

The Examiner has cited no support for any such suggestion or motivation for the modifications from within the reference, and neither does the Examiner provide any references or other prior art supporting any motivation to make the suggested modifications.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP § 2144).

Accordingly, the rejection for obviousness is not supported by the Office Action and thus the rejection is improper, and should be withdrawn.

Moreover, with regard to claim 5, the asserted combination of NUOVO, KIM and KATO does not teach or suggest all features of the claimed invention. NUOVO does not

disclose each and every feature, as required in claims 5. In particular, NUOVO does not disclose an opening portion for storing a second information recording medium storage portion covered by an open/close lid in a manner that the lid moves in a direction orthogonal to a housing direction of the second information recording medium and rotates in a freely closing an opening manner with respect to the housing, as required in claim 5.

NUOVO does not disclose any information recording medium and therefore does not teach or suggest an opening portion for a recording medium or a lid. KIM discloses a latching device 150 includes a lever 152 pivotally connected at 154 to the back of the housing of the device 100, with a tab 156 extending along the side of the device and over a portion of the socket 120A in the closed position (see column 3, lines 15-23 and Figs. 3 and 4 of KIM). However, KIM does not disclose a lid that moves in a direction orthogonal to a housing direction before it rotates in a freely closing and opening manner. In the claimed invention, the lid first shifts in the direction orthogonal to the attaching direction of the SD card 123 and then rotates to open the lid or rotates to close the lid and shifts in the direction orthogonal to the attaching direction of the SD card 123 (see page 24, lines 6-15 and Fig. 8(a)-8(d) of the specification) in order to avoid accidental open when the portable telephone is dropped (see page 26, lines 17-24 of the specification). To the contrary, KIM's latching device 150 is simply pivoted to the open position shown in dashed lines in Fig. 4 of KIM. Thus, KIM does not teach or suggest an opening portion for storing a second information recording medium storage portion covered by an open/close lid in a manner that the lid moves in a direction orthogonal to a housing direction of the second information recording medium and rotates in a freely closing an opening manner with respect to the housing, as required in claim 5.


KATO does not disclose any information recording medium and therefore does not teach or suggest an opening portion for a recording medium or a lid. Thus, the asserted combination of NUOVO, KIM and KATO does not render the subject invention obvious

because the combination fails to disclose, suggest, or teach every feature of the claimed invention. Accordingly, withdrawal of this rejection is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 37107.

Respectfully submitted,  
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